

REMARKS

Forty-five claims are pending in the present Application. Claims 1-45 currently stand rejected. Claims 1, 21, 44, and 45 are amended herein. Reconsideration of the Application in view of the foregoing amendments and the following remarks is respectfully requested.

Claim Objections

On page 2 of the Office Action, the Examiner objects to claim 45 because of “insufficient antecedent basis” for certain limitations. Accordingly, Applicants herein amend claim 45 to correct the foregoing antecedent basis problems. In view of the foregoing remarks and amendments, Applicants believe that the Examiner’s objections are addressed, and respectfully request that the objection be withdrawn so that the present Application may issue in a timely manner.

Title

On page 3 of the Office Action, the Examiner states that “[a] new title is required that is clearly indicative of the invention to which the claims are directed.” In response, Applicants herein amend the Title in accordance with the Examiner’s suggestions. In view of the foregoing remarks and amendments, Applicants believe that the Examiner’s objection is addressed, and respectfully request that the objection be withdrawn so that the present Application may issue in a timely manner.

35 U.S.C. § 102(b)

On page 6 of the Office Action, the Examiner rejects claims 1-2, 4, 21-22, 42, and 43 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,393,470 to Kanevsky et al. (hereafter Kanevsky). The Applicants respectfully traverse these rejections for at least the following reasons.

“For a prior art reference to anticipate in terms of 35 U.S.C. §102, every element of the claimed invention must be *identically* shown in a single reference.” *Diversitech Corp. v. Century Steps, Inc.*, 7 USPQ2d 1315, 1317 (CAFC 1988). The Applicants submit that Kanevsky fails to identically teach every element of the claims, and therefore does not anticipate the present invention.

Regarding the Examiner’s rejection of independent claims 1 and 21, Applicants respond to the Examiner’s §102 rejection as if applied to amended independent claims 1 and 21. For example, amended independent claim 1 now recites “a transfer manager of said imaging device for transferring said data from said imaging device to said data destination, said transfer manager monitoring said data buffers, and automatically transferring said data if said data stored in said data buffers exceeds a predetermined threshold amount,” which are limitations that are not taught or suggested either by the cited reference, or by the Examiner’s citations thereto.

Kanevsky teaches a network of servers that wirelessly monitor portable electronic devices until one of the servers “detects that some embedded computer, e.g. (video) camera, is near full” (see column , lines 14-15). In Kanevsky, when a server detects that a camera is nearly full of image data, then “this server

moves stored images to a storage server” (see column 2, lines 27-28).

Kanevsky therefore discloses a “pull” operation in which an external server network monitors portable devices, and actively pulls the image data from the portable devices.

In contrast, independent claims 1 and 21 affirmatively recite “a transfer manager of said imaging device for transferring said data from said imaging device to said data destination.” Unlike Kanevsky, Applicants’ explicitly recite the transfer manager of the imaging device “*monitoring said data buffers, and automatically transferring said data if said data stored in said data buffers exceeds a predetermined threshold amount.*” Applicants thus disclose and claim a “push” operation in which the imaging device monitors its own memory storage level, and actively pushes the image data to a specified destination. For at least the foregoing reasons, Applicants therefore submit that independent claims 1 and 21 are not anticipated by the teachings of Kanevsky.

Regarding the Examiner’s rejection of dependent claims 2, 4, 22, 24, 42, and 43, for at least the reasons that these claims are directly or indirectly dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or suggested. Applicants therefore respectfully request reconsideration and allowance of dependent claims 2, 4, 22, 24, 42, and 43,, so that these claims may issue in a timely manner.

Because a rejection under 35 U.S.C. §102 requires that every claimed limitation be *identically* taught by a cited reference, and because the Examiner fails to cite Kanevsky to identically teach or suggest the claimed invention, Applicants respectfully request reconsideration and allowance of claims 1-2, 4, 21-22, 42, and 43, so that these claims may issue in a timely manner.

35 U.S.C. § 102(b)

On page 7 of the Office Action, the Examiner rejects claim 44 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,737,491 to Allen et al. (hereafter Allen). The Applicants respectfully traverse these rejections for at least the following reasons.

“For a prior art reference to anticipate in terms of 35 U.S.C. §102, every element of the claimed invention must be *identically* shown in a single reference.” *Diversitech Corp. v. Century Steps, Inc.*, 7 USPQ2d 1315, 1317 (CAFC 1988). The Applicants submit that Allen fails to identically teach every element of the claims, and therefore does not anticipate the present invention.

Regarding the Examiner’s rejection of independent claim 44, Applicants respond to the Examiner’s §102 rejection as if applied to amended independent claim 44 which now recites “a transfer manager automatically transfers said data if said data stored in said data buffers exceeds a predetermined threshold amount,” which are limitations that are not taught or suggested either by the cited reference, or by the Examiner’s citations thereto.

Allen teaches a camera device that transmits images to a “fulfillment server” in response to user voice commands recognized by a speech recognition system. In particular “a photographer captures the image of a scene with the digital camera 10, and verbally instructs the camera to perform one or more of the command functions listed in Table 1” (column 3, lines 49-52). In contrast, independent claim 44 affirmatively recites “automatically” performing a data transfer in response to a predetermined threshold. Applicants therefore submit that independent claim 44 is not anticipated by the teachings of Allen.

Because a rejection under 35 U.S.C. §102 requires that every claimed limitation be *identically* taught by a cited reference, and because the Examiner fails to cite Allen to identically teach or suggest the claimed invention, Applicants respectfully request reconsideration and allowance of claim 44 so that this claim may issue in a timely manner.

35 U.S.C. § 103

On page 8 of the Office Action, the Examiner rejects claims 3 and 23 under 35 U.S.C. § 103 as being unpatentable over Kanevsky in view of Allen. The Applicants respectfully traverse these rejections for at least the following reasons.

Applicants maintain that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a) which requires that three basic criteria must be met, as set forth in M.P.E.P. §2142:

"First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of

ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations."

The initial burden is therefore on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Regarding the Examiner's rejection of dependent claims 3 and 23, for at least the reasons that these claims are directly or indirectly dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or suggested. Applicants therefore respectfully request reconsideration and allowance of dependent claims 3 and 23, so that these claims may issue in a timely manner.

For at least the foregoing reasons, the Applicants submit that claims 3 and 23 are not unpatentable under 35 U.S.C. § 103 over Kanevsky in view of Allen, and that the rejections under 35 U.S.C. § 103 are thus improper. The Applicants therefore respectfully request reconsideration and withdrawal of the rejections of claims 3 and 23 under 35 U.S.C. § 103.

On page 9 of the Office Action, the Examiner rejects claims 5, 25, and 41 under 35 U.S.C. § 103 as being unpatentable over Kanevsky in view of

Examiner's Official Notice. The Applicants respectfully traverse these rejections for at least the following reasons.

Applicant maintains that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a). As discussed above, for a valid *prima facie* case of obviousness under 35 U.S.C. § 103(a), the prior art references when combined must teach or suggest all the claim limitations." The initial burden is on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Regarding the Examiner's rejection of dependent claims 5, 25, and 41, for at least the reasons that these claims are directly or indirectly dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or suggested. Applicants therefore respectfully request reconsideration and allowance of dependent claims 5, 25, and 41, so that these claims may issue in a timely manner.

In addition, with regard to the rejections of claims 5, 25, and 41, the Examiner concedes that "Kanevski (sic) does not expressly disclose said data buffers being economically implemented." Applicants concur. However, without providing any further references in support of the rejections of claim 5, 25, and 41, the Examiner then states that "Official Notice is taken"

Applicants submit that it would not have been obvious to a person of ordinary skill the art at the time of the invention to develop the claimed invention

in order to economically implement a portable device with a “reduced memory-size configuration” or “without removable storage media capabilities.” Applicants therefore respectfully request the Examiner to cite specific references in support of these rejections, and failing to do so, to reconsider and withdraw the rejections of claims 5, 25, and 41, so that the present Application may issue in a timely manner.

Furthermore, the Court of Appeals for the Federal Circuit has held that “obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination.” In re Geiger, 815 F.2d 686, 688, 2 U.S.P.Q.2d 1276, 1278 (Fed. Cir. 1987). Applicants submit that there is no teaching of a combination that would result in Applicant’s invention, and therefore the obviousness rejection under 35 U.S.C §103 is not proper.

Applicants submit that the cited references, in combination with the Official Notice, do not suggest a combination that would result in Applicants’ invention, and therefore the obviousness rejections under 35 U.S.C §103 are improper. Applicants therefore respectfully request the Examiner to cite references in support of the Official Notice, and to also indicate where an explicit teaching to combine the cited references may be found. Alternately, the Applicants request that the Examiner reconsider and withdraw the rejections of claims 5, 25, and 41 under 35 U.S.C §103.

For at least the foregoing reasons, the Applicants submit that claims 5, 25, and 41 are not unpatentable under 35 U.S.C. § 103 over Kanevsky in view of

Examiner's Official Notice, and that the rejections under 35 U.S.C. § 103 are thus improper. The Applicants therefore respectfully request reconsideration and withdrawal of the rejections of claims 5, 25, and 41 under 35 U.S.C. § 103.

On page 11 of the Office Action, the Examiner rejects claims 6-10, 12, 15, 17-20, 26-30, 32, 35, and 37-40 under 35 U.S.C. § 103 as being unpatentable over Kanevsky in view of Examiner's Official Notice, and further in view of U.S. Patent No. 6,522,352 to Strandwitz et al. (hereafter Strandwitz). The Applicants respectfully traverse these rejections for at least the following reasons.

Applicant maintains that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a). As discussed above, for a valid *prima facie* case of obviousness under 35 U.S.C. § 103(a), the prior art references when combined must teach or suggest all the claim limitations." The initial burden is on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Applicants respectfully traverse the Examiner's assertion that modification of the device of Kanevsky according to the teachings of Strandwitz would produce the claimed invention. Applicants submit that Kanevsky in combination with Strandwitz fail to teach a substantial number of the claimed elements of the present invention. Furthermore, Applicants also submit that neither Kanevsky nor Strandwitz contain teachings for combining the cited references to produce the Applicants' claimed invention. The Applicants therefore respectfully submit that the obviousness rejections under 35 U.S.C §103 are improper.

Regarding the Examiner's rejection of dependent claims 6-10, 12, 15, 17-20, 26-30, 32, 35, and 37-40, for at least the reasons that these claims are directly or indirectly dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or suggested. Applicants therefore respectfully request reconsideration and allowance of dependent claims 6-10, 12, 15, 17-20, 26-30, 32, 35, and 37-40, so that these claims may issue in a timely manner.

In addition, with regard to claims 15 and 35, Applicants submit that neither Kanevsky nor Strandwitz teach that "a controller of said data destination sends an error message to said imaging device by said wireless communications network after determining that said data and said identification information have not been successfully received, said transfer manager responsively repeating said data transfer procedure to retransmit said data from said data buffers to said data destination", as recited by Applicants in claims 15 and 35.

Furthermore, with regard to claims 10 and 30, Applicants submit that the cited references nowhere teach or disclose providing status information regarding at least one of said data transfer procedure and said arbitration procedure by using a user interface . . . ,” as recited by Applicants in claims 10 and 30.

For at least the foregoing reasons, the Applicants submit that claims 6-10, 12, 15, 17-20, 26-30, 32, 35, and 37-40 are not unpatentable under 35 U.S.C. § 103 over the cited references, and that the rejections under 35 U.S.C. § 103 are

thus improper. The Applicants therefore respectfully request reconsideration and withdrawal of the rejections of claims 6-10, 12, 15, 17-20, 26-30, 32, 35, and 37-40 under 35 U.S.C. § 103.

On page 15 of the Office Action, the Examiner rejects claims 11 and 31 under 35 U.S.C. § 103 as being unpatentable over Kanevsky in view of Examiner's Official Notice and Strandwitz, and still further in view of U.S. Patent No. 5,128,776 to Scorse et al. (hereafter Scorse). The Applicant respectfully traverses these rejections for at least the following reasons.

Applicant maintains that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a). As discussed above, for a valid *prima facie* case of obviousness under 35 U.S.C. § 103(a), the prior art references when combined must teach or suggest all the claim limitations." The initial burden is on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Regarding the Examiner's rejection of dependent claims 11 and 31, for at least the reasons that these claims are directly or indirectly dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or suggested. Applicants therefore respectfully request reconsideration and allowance of dependent claims 11 and 31, so that these claims may issue in a timely manner.

For at least the foregoing reasons, the Applicants submit that claims 11 and 31 are not unpatentable under 35 U.S.C. § 103 over Allen in view of Strandwitz and Scorse, and that the rejections under 35 U.S.C. § 103 are thus improper. The Applicants therefore respectfully request reconsideration and withdrawal of the rejections of claims 11 and 31 under 35 U.S.C. § 103.

On page 16 of the Office Action, the Examiner rejects claims 13, 14, 16, and 33-36 under 35 U.S.C. § 103 as being unpatentable over Kanevsky in view of Examiner's Official Notice and Strandwitz, and still further in view of U.S. Patent No. 6,058,304 to Callaghan et al. (hereafter Callaghan). The Applicant respectfully traverses these rejections for at least the following reasons.

Applicant maintains that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a). As discussed above, for a valid *prima facie* case of obviousness under 35 U.S.C. § 103(a), the prior art references when combined must teach or suggest all the claim limitations." The initial burden is on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Regarding the Examiner's rejection of dependent claims 13, 14, 16, and 33-36, for at least the reasons that these claims are directly or indirectly dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or suggested. Applicants therefore respectfully request

reconsideration and allowance of dependent claims 13, 14, 16, and 33-36, so that these claims may issue in a timely manner.

For at least the foregoing reasons, the Applicants submit that claims 13, 14, 16, and 33-36 are not unpatentable under 35 U.S.C. § 103 over the cited references, and that the rejections under 35 U.S.C. § 103 are thus improper. The Applicants therefore respectfully request reconsideration and withdrawal of the rejections of claims 13, 14, 16, and 33-36 under 35 U.S.C. § 103.

Rejection Of Independent Claim 45

With regard to claim 45, “means-plus-function” language is utilized to recite elements and functionality similar to those recited in claims 1 and 21 as discussed above. Applicants therefore incorporate those remarks by reference with regard to claim 45. In addition, the Courts have frequently held that “means-plus-function” language, such as that of claim 45, should be construed in light of the Specification. More specifically, means-plus-function claim elements should be *construed to cover the corresponding structure, material or acts described in the specification*, and equivalents thereof. Applicants respectfully submit that, in light of the substantial differences between the teachings of Allen and Applicants’ invention as disclosed in the Specification, claim 45 is therefore not anticipated or made obvious by the teachings of Allen.

Summary

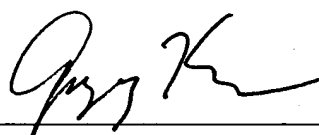
Applicants submit that the foregoing amendments and remarks overcome the Examiner's objections and rejections. Because the cited references, or the Examiner's citations thereto, do not teach or suggest the claimed invention, and in light of the differences between the claimed invention and the cited prior art, Applicants therefore submit that the claimed invention is patentable over the cited art, and respectfully request the Examiner to allow claims 1-45 so that the present Application may issue in a timely manner. If there are any questions concerning this amendment, the Examiner is invited to contact the Applicants' undersigned representative at the number provided below.

Respectfully submitted,

Date: _____

7/3/05

By: _____



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